

*if
cont'd*

-SR¹⁵, -OSiR₃¹⁵, -SiR₃¹⁵ or -PR₂¹⁵ radical in which R¹⁵ is a halogen atom, a C₁-C₁₀-alkyl group or a C₆-C₁₀-aryl group --

REMARKS

The applicants respectfully request reconsideration in view of the amendment and the following remarks. Support for amended claims 1 and 19 can be found in the original claim 1. The applicants have canceled the possibility that R³ is methyl in claims 1 and 19. Support for newly added claims 25 and 26 can be found in the original claim 1. The applicants have rewritten claim 7 into independent form. The fee of \$36.00 is enclosed for the two additional claims over twenty which were added.

Claims 1, 2, 4-15 and 19 and 20 were rejected under 35 USC §102(b) as anticipated by or, in the alternative, under 35 USC §103(a) as obvious over Japanese 62-121707 ("Mitsui"), alone or in view of JACS (1967) 89 (23) pgs. 5868-5876 ("JACS") or applicants' acknowledgments. Claims 21-24 were rejected under 35 U.S.C. §103(a) as unpatentable over Mitsui, alone or in view of JACS or applicants' acknowledgments as applied in the preceding rejection. Claim 3 was objected to as being dependent on a rejected base claim but would be allowable if rewritten in independent form to include all the limitations of the base claim and any intervening claim. The applicants respectfully traverse these rejections.

The Examiner rejected the application as being anticipated by, or rendered obvious over Mitsui, because Mitsui mentions the metallocene ethylene bis(2,3-dimethyl-1-indenyl)zirconium dichloride. The Examiner studied the Derwent Abstract of the document and stated that this compound is one of 7 metallocenes listed there. However, enclosed is an English translation of the whole text of Mitsui. At page 32, there are mentioned 20 metallocenes which contain zirconium, from which only one, ethylene bis(2,3-dimethyl-1-indenyl)zirconium dichloride, is substituted in the 2-position. In addition, Mitsui discloses 2 species of titanium metallocenes and two species of hafnium metallocenes which are not substituted in the 2-position. Therefore, out of the 24 species, there is only one metallocene substituted at the 2-position. With respect the species substituted at the 2-position, the applicants' claimed invention no longer covers this species.

The applicants have three independent claims (claims 1, 7 and 19). In the applicants' claims 1 and 19, R^3 is not methyl. It is noted that R^3 can be C_2 - C_{10} -alkyl or a C_1 - C_{10} alkyl which is halogenated. In claim 7, R^3 and R^4 are not methyl but hydrogen. Furthermore, Mitsui does not use this species in any of its 10 examples and does not give any hint that there are any advantages using it.

The Examiner alleges the compounds of the present claims and those mentioned by Mitsui being equivalent (see first paragraph of page 6 of the Office Action). However, unexpectedly and not foreseeable from the prior art, polypropylenes obtained by the metallocenes of the present invention have a higher melting point, i.e. a higher isotacticity

(see the bottom of column 9 of the reissue specification), as a result of the substitution at the 2 position. This is proven by the examples of the present application.

By comparing examples (Comparative Examples 1-C of the application are inventive examples according to the present claims) and comparative examples wherein the polymerization is carried out at the same temperature and the metallocenes differ only by the substitution in the 2 position (that is comparing Examples 1 and 2 versus comparative D and E (150 and 154 versus 141 and 143 respectively). Compare comparative example B (according to the invention) to comparative example G; and comparative example C (according to the invention) to comparative example H). It is shown that the polypropylenes polymerized with the 2-substituted metallocenes always have a melting point which is 5 to 11 °C higher than the melting point of polypropylenes which are obtained by metallocenes without substitution in the 2-position. This advantage was actually not foreseeable from the art.

The Examiner must consider the references as a whole, In re Yates, 211 USPQ 1149 (CCPA 1981). The Examiner cannot selectively pick and choose from the disclosed multitude of parameters without any direction as to the particular one selection of the reference without proper motivation. The mere fact that the prior art may be modified to reflect features of the claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by the prior art (In re Fritch, 23 USPQ 2nd. 1780 (Fed. Cir. 1992)). The applicants disagree with the

Examiner why one skilled in the art with the knowledge of the references would selectively modify the references in order to arrive at the applicants' claimed invention. The Examiner's argument is clearly based on hindsight reconstruction.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting this combination, although it may have been obvious to try various combinations of teachings of the prior art references to achieve the applicant's claimed invention, such evidence does not establish *prima facie* case of obviousness (*In re Geiger*, 2 USPQ 2d. 1276 (Fed. Cir. 1987)). There would be no reason for one skilled in the art to combine Fritz in view of JACS. For the above reasons, this rejection should be withdrawn.

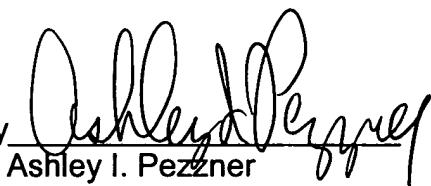
The applicants have filed a declaration regarding the original patent on October 7, 1999 in the reissue application serial No. 08/324,260. Enclosed is a copy of the Declaration. The applicants believe that the declaration meets the requirements that the original patent cannot be found.

No fee is due. If there are any additional fees due in connection with the filing of this response, including any fees required for an additional extension of time under 37 CFR 1.136, such an extension is requested and the Commissioner is authorized to charge or credit any overpayment to Deposit Account No. 03-2775.

For the reasons set forth above, Applicants believe that the claims are patentable over the references cited and applied by the Examiner and a prompt and favorable action is solicited. The applicants believe that these claims are in condition for allowance, however, if the Examiner disagrees, the applicants respectfully request that the Examiner telephone the undersigned at (302) 888-6270.

Respectfully submitted,

CONNOLLY BOVE LODGE & HUTZ LLP

By 
Ashley I. Pezzner
Registration No. 35,646
Telephone: 302/888-6270

AIP/ebd
Enclosures
::ODMA\MHODMA\CB;94281;1